

REMARKS**I. General**

Claims 1-14 are pending in the present application. Applicant notes with appreciation that claim 8 is indicated by the Examiner as containing allowable subject matter. Claims 1-7 and 9-12 stand rejected under 35 U.S.C. § 103(a). Claims 1-12 stand rejected under the judicially created doctrine of double patenting. Claims 5 and 6 are amended. Claims 13 and 14 are new, and support for those claims can be found at least at page 12, line 25 through page 13, line 12 and page 38, lines 7-14 of the application. Applicant respectfully traverses the rejections of record.

II. The Double Patenting Rejection

Claims 1-12 stand rejected under the judicially created doctrine of double patenting over claims 1-47 of United States patent number 6,233,568. Applicant proposes filing a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) if the Examiner's rejections still stand upon indication that the claims of the present application are otherwise allowable. Applicant notes that future amendments to the claims of this present application may result in the withdrawal of this rejection. Applicant respectfully requests that the Examiner reconsider this rejection in view of the amendments made to the claims of the present application.

III. The 35 U.S.C. § 103 Rejections**Claims 1, 3, 9, and 10**

Claims 1, 3, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Piccione, United States patent number 4,495,581 (hereinafter *Piccione*), or Barns-Slavin et al., United States patent number 5,117,346 (hereinafter *Barns-Slavin*), or Thiel, European patent publication number 0805422 (hereinafter *Thiel EP*), or Thiel, United States patent number 5,699,258 (hereinafter *Thiel US1*), or Thiel, United States patent number 6,035,291 (hereinafter *Thiel US2*), or Thiel, United States patent number 6,321,214 (hereinafter *Thiel US3*), in view of Berson et al., United States patent number 6,039,257 (hereinafter *Berson*). Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of record.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the applied references. Second, there must be a reasonable expectation of success. Finally, the applied references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy the third criterion, as discussed further below.

Claim 1 recites, in part:

“A method operable on a general multi-purpose processor-based system...”
and
“...presenting each of said determined values for comparison...”

On pages 3 and 4, the Examiner rejects claim 1 over the alternative combinations of *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Not one of these combinations teaches each and every aspect of claim 1, as discussed below. Accordingly, the U.S.C. § 103(a) rejection of claim 1 should be withdrawn and claim 1 allowed.

The proposed combination of *Piccione* and *Berson* does not teach or suggest every aspect of claim 1. Specifically, the proposed combination does not show, at least, a method operable on a general multi-purpose processor-based system. *Piccione* teaches a user programmable postal rate calculator, but mentions nowhere in the disclosure a method operable on a general multi-purpose processor-based system. See especially Fig. 1, which shows the specialized *Piccione* calculator with buttons and controls specific to the *Piccione* functions. Accordingly, *Piccione* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest a method operable on a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

The proposed combination of *Barns-Slavin* and *Berson* not teach each and every aspect of claim 1. Specifically, the proposed combination does not teach or suggest, at least, a method operable on a general multi-purpose processor-based system. The device of *Barns-Slavin* teaches employing a specialized computer, not a general multi-purpose processor-based system. See especially Fig. 2, which shows the specialized *Barns-Slavin* device.

Accordingly, *Barns-Slavin* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest a method operable on a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

The proposed combination of *Thiel EP* and *Berson* does not teach each and every aspect of claim 1. *Thiel EP* does not teach or suggest, at least, presenting each of said determined values for comparison. *Thiel EP* teaches an automatic carrier selection such that values are never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, (*Thiel EP*, *Thiel US2* and *Thiel US3* disclose the same device.) which discloses the carrier calculation method of the Thiel device. In that method, a display device is used to display a calculated "beneficial carrier;" however, the method does not include presenting each of said determined values for comparison. Accordingly, *Thiel EP* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

The proposed combination of *Thiel US1* and *Berson* does not teach each and every aspect of claim 1. Specifically, the proposed combination does not teach or suggest, at least, a method operable on a general multi-purpose processor-based system. See Col. 5, line 62 through Col. 6, line 12, which describes an assembly of the device disclosed in *Thiel US1*. That passage mentions nothing of general multi-purpose processor-based system; nor does any other passage from the reference mention a general multi-purpose processor-based system. Accordingly, *Thiel US1* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest a method operable on a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

The proposed combination of *Thiel US2* and *Berson* does not teach each and every aspect of claim 1. *Thiel US2* does not teach or suggest, at least, presenting each of said determined values for comparison. *Thiel US2* teaches an automatic carrier selection such that values are never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, (*Thiel EP*, *Thiel US2* and *Thiel US3* disclose the same device.) which discloses the carrier calculation

method of the Thiel device. In that method, a display device is used to display a calculated “beneficial carrier;” however, the method does not include presenting each of said determined values for comparison. Accordingly, *Thiel US2* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

Similarly to the proposed combinations of *Thiel EP* and *Thiel US2* with *Berson*, the proposed combination of *Thiel US3* and *Berson* does not teach each and every aspect of claim 1. *Thiel US3* does not teach or suggest, at least, presenting each of said determined values for comparison. *Thiel US3* teaches an automatic carrier selection such that values are never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, which discloses the carrier calculation method of the Thiel device. In that method, a display device is used to display a calculated “beneficial carrier;” however, the method does not include presenting each of said determined values for comparison. Accordingly, *Thiel US3* does not teach or suggest the above feature of claim 1. The Examiner does not rely on *Berson* to teach or suggest presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 1.

Because each of the proposed alternative combinations fails to teach or suggest at least one of the elements of claim 1, Applicant respectfully submits that the U.S.C. § 103(a) rejection of claim 1 is improper. Accordingly, the rejection should be withdrawn and claim 1 passed to allowance.

Further, claim 9 recites, in part:

“A general multi-purpose processor-based system...”

and

“...means for presenting each of said determined values for comparison...”

On pages 3 and 4, the Examiner rejects claim 9 over the alternative combinations of *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Not one of these combinations teaches each and every aspect of claim 9, as discussed below. Accordingly, the U.S.C. § 103(a) rejection of claim 9 should be withdrawn and claim 9 allowed.

The proposed combination of *Piccione* and *Berson* does not teach or suggest every aspect of claim 9. Specifically, the proposed combination does not show, at least, a general multi-purpose processor-based system. *Piccione* teaches a user programmable postal rate calculator, but mentions nowhere in the disclosure a method operable on a general multi-purpose processor-based system. See especially Fig. 1, which shows the specialized *Piccione* calculator with buttons and controls specific to the *Piccione* functions. Accordingly, *Piccione* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

The proposed combination of *Barns-Slavin* and *Berson* not teach each and every aspect of claim 9. Specifically, the proposed combination does not teach or suggest, at least, a general multi-purpose processor-based system. The device of *Barns-Slavin* teaches employing a specialized computer, not a general multi-purpose processor-based system. See especially Fig. 2, which shows the specialized *Barns-Slavin* device. Accordingly, *Barns-Slavin* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

The proposed combination of *Thiel EP* and *Berson* does not teach each and every aspect of claim 9. *Thiel EP* does not teach or suggest, at least, means for presenting each of said determined values for comparison. *Thiel EP* teaches an automatic carrier selection such that values are never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, (*Thiel EP*, *Thiel US2* and *Thiel US3* disclose the same device.) which discloses the carrier calculation method of the Thiel device. In that method, a display device is used to display a calculated "beneficial carrier;" however, the method does not include means for presenting

each of said determined values for comparison. Accordingly, *Thiel EP* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest means for presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

The proposed combination of *Thiel US1* and *Berson* does not teach each and every aspect of claim 9. Specifically, the proposed combination does not teach or suggest, at least, a general multi-purpose processor-based system. See Col. 5, line 62 through Col. 6, line 12, which describes an assembly of the device disclosed in *Thiel US1*. That passage mentions nothing of a general multi-purpose processor-based system; nor does any other passage from the reference mention a general multi-purpose processor-based system. Accordingly, *Thiel EP* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest a general multi-purpose processor-based system; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

The proposed combination of *Thiel US2* and *Berson* does not teach each and every aspect of claim 9. *Thiel US2* does not teach or suggest, at least, means for presenting each of said determined values for comparison. *Thiel US2* teaches an automatic carrier selection such that values are never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, (*Thiel EP*, *Thiel US2* and *Thiel US3* disclose the same device.) which discloses the carrier calculation method of the Thiel device. In that method, a display device is used to display a calculated "beneficial carrier;" however, the method does not include means for presenting each of said determined values for comparison. Accordingly, *Thiel US2* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest means for presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

Similarly to the proposed combinations of *Thiel EP* and *Thiel US2* with *Berson*, the proposed combination of *Thiel US3* and *Berson* does not teach each and every aspect of claim 9. *Thiel US3* does not teach or suggest, at least, means for presenting each of said determined values for comparison. *Thiel US3* teaches an automatic carrier selection such that values are

never presented for comparison. See Col. 20, lines 10-17 of *Thiel US3*, which discloses the carrier calculation method of the Thiel device. In that method, a display device is used to display a calculated “beneficial carrier;” however, the method does not include means for presenting each of said determined values for comparison. Accordingly, *Thiel US3* does not teach or suggest the above feature of claim 9. The Examiner does not rely on *Berson* to teach or suggest means for presenting each of said determined values for comparison; nor does *Berson* teach or suggest such a feature. Thus, the proposed combination does not teach or suggest every aspect of claim 9.

Because each of the proposed alternative combinations fails to teach or suggest at least one of the aspects of claim 9, Applicant respectfully submits that the U.S.C. § 103(a) rejection of claim 9 is improper. Accordingly, the rejection should be withdrawn and claim 9 passed to allowance.

Dependent claims 3 and 10 each depend either directly or indirectly from one of independent claims 1 and 9 and thus inherit all of the limitations of their respective independent claims. As shown above, the numerous proposed alternative combinations do not teach or suggest each and every aspect of independent claims 1 and 9. Thus, it is respectfully submitted that dependent claims 3 and 10 are allowable at least because of their dependencies from their respective independent claims 1 and 9 for the reasons discussed above.

Claims 2, 7, 11, and 12

Claims 2, 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of record because of lack of motivation to modify and failure to teach all claim limitations.

Lack of Motivation to Modify

On page 4 of the Office Action the Examiner states that it is well known to use a secure accounting unit and that the cited references teach employing a general purpose processor-based system to account for dispensed shipping. The Examiner then states that based on that which is “well known in the art” and the cited references that it would have

been obvious to modify the cited references such that the systems allegedly disclosed by each “would contain a secure accounting unit/memory connected to a processing unit.” The Examiner, however, fails to suggest the desirability for such a modification. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The language is circular in nature, stating that it is obvious to make the modification (using a secure accounting unit) because it is obvious to achieve the result (connecting to a processing unit a secure accounting unit/memory). Such language is merely a statement that the references can be modified, and does not state any desirability for making the modifications. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the modifications is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 2, 7, 11, and 12 fails.

Failure to Teach or Suggest All Claimed Limitations

Dependent claims 2, 7, 11, and 12 each depend either directly or indirectly from one of independent claims 1 and 9 and thus inherit all of the limitations of their respective independent claims. As shown above, claims 1 and 9 recite elements not taught or suggested by the numerous proposed alternative combinations of either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Further, the Examiner does not cite anything in addition to those combinations that recites those missing elements. Thus, it is respectfully submitted that dependent claims 2, 7, 11, and 12 are allowable at least because of their dependencies from their respective independent claims 1 and 9 for the reasons discussed above.

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of record because of lack of motivation to combine and failure to teach all claim limitations.

Lack of Motivation to Combine

On page 4 of the Office Action, the Examiner states that it is well known to use an indicia similar to the town circle, box, and bird of PITNEY BOWES. The Examiner then states that it would be obvious to combine such an indicia with the systems allegedly disclosed in the cited references such that the resulting modifications “would use an indicia that includes graphic information.” The Examiner, however, fails to suggest the desirability for such a combination. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The language is circular in nature, stating that it is obvious to make the modification (modifying the cited references to include a bird) because it is obvious to achieve the result (using an indicia that includes graphic information). Such language is merely a statement that the references can be combined, and does not state any desirability for making the combinations. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combinations, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the failure to provide motivation suggesting desirability of the combinations is improper. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 4 fails.

Failure to Teach or Suggest All Claimed Limitations

Dependent claim 4 depends indirectly from independent claim 1, and thus inherits all of the limitations of claim 1. As discussed above, independent claim 1 recites features not taught or suggested by the alternative combinations of either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. Since the Examiner does not rely on the PITNEY BOWES bird to supply those missing elements to the numerous proposed combinations cited against claim 1, not each and every element of claim 4 is taught or suggested by the proposed combinations in the instant rejection. Thus, it is respectfully submitted that dependent claim 4 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Claims 5 and 6

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson* in further view of *Vermesse*, United States patent number 4,914,606 (hereinafter *Vermesse*) or *Ramsden*, United States patent number 5,233,532 (hereinafter, *Ramsden*). Applicant respectfully traverses the 35 U.S.C. § 103(a) rejection of record because of failure to teach or suggest all claimed limitations.

Dependent claims 5 and 6 depend indirectly from independent claim 1, and thus inherit all of the limitations of claim 1. As discussed above, independent claim 1 recites features not taught or suggested by the numerous alternative combinations of either *Piccione*, or *Barns-Slavin*, or *Thiel EP*, or *Thiel US1*, or *Thiel US2*, or *Thiel US3*, in view of *Berson*. The Examiner does not rely on *Vermesse* or *Ramsden* to supply those missing features to the numerous proposed combinations cited against claim 1; nor do *Vermesse* or *Ramsden* teach or suggest those missing features. Accordingly, not each and every feature of claims 5 and 6 is taught or suggested by the proposed combinations in the instant rejection. Thus, it is respectfully submitted that dependent claims 5 and 6 are allowable at least because of their dependency from independent claim 1 for the reasons discussed above.

IV. New Claims

Claims 13 and 14 are added by this amendment. It is respectfully submitted that dependent claims 13 are allowable not only because of their respective dependencies from base claims 1 and 9 for the reasons discussed above, but also in view of their novel claim features which narrow the scope of the particular claims and compel a broader interpretation of the independent claim from which they depend.

V. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

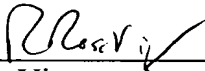
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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P000C2CP1C1/10106029 from which the undersigned is authorized to draw.

Dated: December 19, 2003

Respectfully submitted,

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